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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,460	12/10/2003	Koji Shima	450137-04920	8843
20999 7590 07/31/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER NOORISTANY, SULAIMAN	
			ART UNIT 2109	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,460

Applicant(s)

SHIMA, KOJI

Examiner

Sulaiman Nooristany

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Detailed Action

This Office Action is response to the Non-provisional patent application (10/733460) filed on Dec 20, 2003.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. **Claims 15-16** recite "A program executable by a computer ..." which is directed at a computer program. A computer program is non-statutory because it is not considered a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Because the claim may be directed toward a program the claim as a whole is considered non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.

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Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by **Parker et al.**

U.S. Patent No. **US 7,099,288**.

Regarding claims 1 & 2, Parker teaches method as well as the system wherein a network system (**a server system over a public data network (Abstract, lines 3-4)**), including:

a client terminal which requests a peer-to-peer communication (**Fig. 3, unit 28 (send access request to server), Fig. 2, unit 10 (user #1 & unit 11 (user # 2))**); and

a host terminal which supports establishing a connection of the peer-to-peer communication (**The present invention relates to establishing a communication session between users connected to a computer network (Col. 1, lines 15-18), server system would set-up the video call and provide the appropriate data addresses to user systems for a peer to peer video transfer over public data network (Col. 9 , lines 24-27))**),

wherein said client terminal generates a request message that contains an IP address of said own client terminal (**individual users have their own static IP addresses (Col. 1, lines 64-65)**) , and said client terminal sends out the request message to said host terminal via a transmission mail server (**A mail server with an easy to remember domain name acts as intermediary between two individual users (Col. 2, lines 4-5)**),

wherein said host terminal acquires the request message via a reception mail server (**An access request to establish a data transfer to a desired user on the**

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internetwork is requested in the server (Col. 2, lines 61—63)), said host terminal extracts the IP address of said client terminal from a description content of the request message (**Fig. 3, unit 30 (Look-up target telephone number and get IP address)**), said host terminal stores the extracted IP address in a table (**Fig. 3, unit 23 & 26 (add user or update status in table)**), The database includes for each registered user a respective a respective IP address (**Col. 2, lines 60-61**), said host terminal selects at least one IP address from the table and generates a reply message containing the thus selected at least one IP address (**Fig. 3, unit 30 (Look-up target telephone number and get IP address) & unit 31 (Send initiation message)**), an initiation message is forwarded to the desired user using a respective IP address stored in the database (**Col. 3, lines 1-2**)), and said host terminal sends out the reply message to said client terminal via the transmission mail server (**mail server with an easy to remember domain name acts as intermediary between two individual users (Col. 2, lines 4-5)**), and

wherein said client terminal acquires the reply message via the reception mail server ((**Fig. 4, Packets from user #1 to user #2 computer 11**), **Fig. 2, unit 32 (Invoke client application and prompt user #2 for accept or reject)**) said client terminal extracts at least one IP address of other terminals from a description content of the rely message (**the IP address is typically embedded in each packet forwarded by the network and the central server preferably extracts the automatically embedded IP address and port number so that the user does not need to know it (Col. 5, lines 34-37)**), At central server, each packet is redirected by substitution of

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IP addresses (Col. 6, lines 42-43)), and said client terminal starts a peer-to-peer communication of data transmission and reception with another terminal which is specified based on the thus extracted IP address (after a desired user accepts the data call and central server notifies the first user of the acceptance, both endpoints continue to address their sent packets to central server. At central server, each packet is redirected by substitution of IP addresses (Col. 6, lines 38-43))

Regarding claim 3, parker taught a method according to Claim 2 [See above rejection]. Parker further teaches, wherein said generating a request message includes encrypting the IP address and including the thus encrypted IP address in the request message (Systems would typically apply compression, encryption (Col. 10, lines 65-67), The software could provide video processing, compression, and encryption (Col. 15, lines 59-60)), and wherein said extracting by the host terminal includes extracting the encrypted message from the request message and decoding the thus extracted encrypted message (Fig. 14, unit (Interface device 704 includes DTMF decoder 723), DTMF decoder monitors the telephone connection between jacks to detect and decode any DTMF tones transmitted by telephone to the public telephone network (Col. 13, lines 31-34, Col. 14, lines 5-45)).

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Regarding claim 4, parker taught a method according to Claim 2 [See above rejection]. Parker further teaches, wherein said generating a reply message includes encrypting the at least one IP address and including the thus encrypted IP address in the reply message Systems would typically apply compression, encryption (Col. 10, lines 65-67), **The software could provide video processing, compression, and encryption (Col. 15, lines 59-60)),** and wherein said selecting by the host terminal includes selecting the encrypted at least one IP address and then decoding it (**Fig. 14, unit (Interface device 704 includes DTMF decoder 723) , DTMF decoder monitors the telephone connection between jacks to detect and decode any DTMF tones transmitted by telephone to the public telephone network (Col. 13, lines 31-34, Col. 14, lines 5-45)).**

Claim 5 has the similar limitation as those claims 1 & 2; therefore, it's rejected under the same rationale as in claim 1 & 2.

Regarding claim 6, parker taught a method according to Claim 5 [See above rejection]. Parker further teaches, wherein said data generator encrypts the IP address and has the encrypted IP address contained in the request message, and said selection processing unit extracts the encrypted IP address from the reply message and decodes the extracted IP address **(the caller and called party may use different quality or encryption levels that are interworked by processing system 803 (Col. 15, lines 45-47), Fig. 14, unit (Interface device 704 includes DTMF decoder 723), DTMF**

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decoder monitors the telephone connection between jacks to detect and decode any DTMF tones transmitted by telephone to the public telephone network (Col. 13, lines 31-34, Col. 14, lines 5-45)).

Regarding claim 7, parker taught a method according to Claim 5 [See above rejection].

Parker further discloses, wherein, if unsuccessful is data transmission and reception with a destination terminal whose IP address is the extracted IP address, said data generator generates a message containing said IP address, and wherein said mail transmission and reception unit sends out to the terminal serving as a host said message indicative of an unsuccessful connection (Fig. 3, units 33-34), If rejected, then user #2 generates a reject message in step 33 and sends it to the central server. In step 34, the central server forwards the reject message to user #1, which then terminates the data portion of the attempted communication session in step 35 (Col. 6, lines 12-16)).

Claim 8 has the similar limitation as those claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

Claim 9 has the similar limitation as claim 6; therefore, it's rejected under the same rationale as in claim 6.

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Regarding claim 10, parker taught a method according to Claim 8 [See above rejection]. Parker further discloses, wherein said address storage unit restricts the number of IP addresses to be stored in the table (**IP address at which an Internet user can be reached by introducing a central server that stores information associating each registered user's IP address with identifying information well known (Col. 2, lines 41-44)**), and overwrites IP addresses stored in the past by those to be stored anew (**Fig. 3, units 23 & 26 (Add user or update status in database)**), In **step 23 & 26, the central server receives the registration message and adds the new user to the database or updates the user status, as necessary (Col. 5, lines 43-51)**).

Regarding claim 11, parker taught a method according to Claim 8 [See above rejection]. Parker further discloses, wherein said data generator selects from the storage content of the table an IP address stored more recently (**an initiation message is forwarded to the desired user using a respective IP address stored in the database (Col. 3, lines 1-3)**).

Regarding claim 12, parker taught a method according to Claim 8 [See above rejection]. Parker further discloses, wherein said mail transmission and reception unit acquires a message containing an IP address of a destination terminal with which the requesting terminal fails to start the data transmission and reception, via the reception mail serve (**If rejected, then user #2 generates a reject message in step 33 and**

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sends it to the central server. In step 34, the central server forwards the reject message to user #1, which then terminates the data portion of the attempted communication session in step 35 (Col. 6, lines 12-16)), and
said extraction processing unit extracts the failure IP address from a description content of the message, and wherein said address storage unit distinguishes the failure IP address from other IP addresses (**Fig. 3, units 33 (reject), unit 34 (forward denial message), unit 35 (terminate data portion of attempted contact))**).

Claim 13 has the similar limitation of claim 2; therefore, it's rejected under the same rationale as in claim 2.

Claim 14 has the similar limitation of claim 2; therefore, it's rejected under the same rationale as in claim 2.

Claim 15 has the similar limitation as those of claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

Claim 16 has the similar limitation as those of claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

Claim 17 has the similar limitation as those of claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

Claim 18 has the similar limitation as those of claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,463,471 to Dreke et al.


U.S. Patent 6,144,671 to Perinpanathan et al.

U.S. Patent App. 2003/0212804 to Hashemi,

U.S. Patent App. 2003/0105812 to Flowers et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sulaiman Nooristany whose telephone number is 571-270-1929. The examiner can normally be reached on Monday Through Friday 7:30 am to 5:00 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Pwu can be reached on 571-272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000

Sulaiman Nooristany (07/20/2007)


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TC 2100